

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

As a preliminary matter, Applicants note the Office Action's acknowledgement of Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d); receipt of all of the certified copies of the priority documents; approval of the drawings filed on December 10, 2003; and consideration of the Information Disclosure Statements submitted on December 10, 2003 and April 16, 2004.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,712,764 to Baker et al. (hereinafter "Baker") in view of U.S. Patent No. 6,621,688 to Burdick.

By this amendment, claim 4 has been canceled without prejudice to or disclaimer of the subject matter contained therein. Independent claim 1 has been amended to incorporate the subject matter of canceled claim 4. Claim 5 has been amended to update its dependence and claims 2, 3 and 6 remain unchanged in the application.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. After amending the claims as set forth above, claims 1-3, 5 and 6 are now pending in this application for consideration.

Applicants respectfully submit that the claims are patentably distinguishable over the cited references as required by § 103. Applicants further submit that none of the cited references, whether considered alone or in combination, discloses Applicants' claimed structure for wiring a wiring harness including *a first portion having a plurality of first connectors for concentrative connection with devices and a control module arranged between the first portion and a second portion* as required by amended independent claim 1. By contrast, the cited references fail to disclose, teach or suggest this claimed feature.

Accordingly, independent claim 1 and claims dependent therefrom are patentably distinguishable over the cited references. This distinction will be further described below.

### **THE CLAIMS DISTINGUISH OVER THE CITED REFERENCES**

All of the claims stand rejected as being unpatentable over the combination of Baker and Burdick. In response, Applicants respectfully traverse these rejections, relying on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

#### **The Cited References Do Not Suggest All Claim Recitations**

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained below), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Embodiments of the present invention are directed to a structure for wiring a wiring harness for an automobile. The structures include, *inter alia*, a housing member having first, second and third portions and a wiring harness. The first portion includes a plurality of first connectors for concentrative connection with devices. The second portion houses an electronic control unit and the third portion is formed of a slim shape and interconnects the first portion and the second portion. The wiring harness is housed in a third portion with the wiring harness interconnecting first connectors and an electronic control unit.

According to one embodiment of the present invention as recited in amended independent claim 1, *a first portion has a plurality of first connectors for concentrative*

*connection with devices and a control module is arranged between the first portion and a second portion.* With this arrangement, the requirement for a plurality of wiring harnesses is eliminated, the labor required for wiring devices to the automobile is reduced, and the manufacturing cost is also reduced (Specification, page 7, line 10 through page 8, line 7).

The primary reference of Baker is directed to a method and apparatus for assembling a vehicle instrument panel structure and electronic components. Baker's method includes fabricating an instrument panel base substrate; applying a conductive pattern to the base substrate; and attaching electronic components to the base substrate in electrical communication with the conductive pattern (Abstract, lines 1-6). Employing Baker's method using "*bus technology*," wire harnesses and connectors are eliminated. For example, Baker states the following:

The functionally integrated instrument panel 36 includes at least one electronics "bus" substrate, such as the instrument panel base substrate 30, which permits interconnection of electrical/electronic components within the instrument panel without using traditional wire harnesses and associated connectors. . . . It allows direct connection of electronic components and modules at distributed locations throughout the instrument panel without the use of intervening wire harnesses or connectors. . . . By enabling direct connection of formerly separate electronic modules and components, the instrument panel bus allows redundant conductors to be eliminated and enables sharing of electronic functions among modules, such as shared power supplies, EMC protection, grounding features, etc. Also, the bulky connectors associated with prior art wire harnesses are eliminated.

(column 3, lines 17-22, 28-31 and 38-44). The Office Action correctly recognizes that Baker does not disclose the claimed wiring harness arranged in a housing member. The Office Action then relies on the Burdick reference to cure this deficiency.

As a preliminary matter, Applicant would like to point out that the wiring harness arranged in a housing is not all that Baker fails to disclose. As stated above, Baker employs bus technology to connect the electronic components to the vehicle instrument panel structure. Employing bus technology eliminates wiring harnesses and connectors. Therefore,

contrary to the Examiner's assertion found on page 2 and 3 of the Office Action, Baker also fails to disclose or suggest the claimed first portion having plural first connectors, the second portion with the electronic control unit and the third portion interconnecting the first and second portions. Thus, there is nothing in the Baker reference that teaches or remotely suggests these claimed features.

The Burdick reference is directed to instrument panel electrical harness assemblies. According to Burdick, electrical harnesses and a junction box assembly are incorporated into an instrument panel to service a number of individual vehicle subsystems (column 1, lines 9-14). As illustrated in FIG. 2 of Burdick, harness network 48 which is housed in panel structural architecture 14, includes a plurality of branches 56-76 terminating in either high current connectors (78, 80 and 82) or low current connectors (84, 86, 88 and 90) corresponding to outputs of electrical subsystems of associated vehicle components (column 4, lines 35-57). Junction box 50 is connected to the harness network 48 via branch 56 (column 3, lines 62-64).

The Burdick reference also fails to disclose or suggest many of the claimed features missing from Baker. For example, Burdick fails to disclose *a first portion having a plurality of first connectors for concentrative connection with devices and a control module is arranged between the first portion and a second portion*. In Burdick, the connector is not provided for a concentrative connection. Instead, the connectors are provided for connection to individual vehicle components as stated above. Applicants respectfully submit that the Burdick reference cannot cure the deficiencies of Baker. Thus, for this reason alone, amended independent claim 1 is allowable. Claims dependent from allowable independent claim 1 are allowable by virtue of their direct or indirect dependence from allowable claim 1 and for containing other patentable features.

In sum, even if the first requirement of MPEP § 2143 is satisfied, the third requirement of MPEP § 2143 is not satisfied in the Office Action, since the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

Lack of Suggestion or Motivation to Modify or Combine the References

The Office Action does not identify where the prior art suggests the desirability of the claimed invention. MPEP § 2143.01, entitled *Suggestion or Motivation to Modify the References*, states that the “prior art *must* suggest the desirability of the claimed invention.” (emphasis added; citations omitted) It further states that obviousness

“can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’”

(Citations omitted.) It is respectfully submitted that the Office Action does not provide a sufficient rationale as to why one of ordinary skill in the art would have been motivated to modify the Baker reference, and thus a *prima facie* case of obviousness has not been established.

True, for the Baker reference, the Office Action states that:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange the wiring harness in a housing member of Baker et al. as suggested by Burdick, for the purpose of protecting the wiring harness to be broken in a dashboard of a vehicle.”

(Office Action, page 3). Applicants respectfully submit that the *result* (“for the purpose of protecting the wiring harness to be broken in a dashboard of a vehicle”) is not the same as a *reason why* one of ordinary skill in the art would be motivated to combine the references, however desirable those results may be.

So, if motivation to combine references to establish a *prima facie* case of obviousness could merely be satisfied by a result-oriented analysis of the prior art, the first requirement (and second requirement) of MPEP § 2143.01 would be completely vitiated. That is, by identifying references that teach each individual element of a claimed invention,

implementation of the teachings of the cited references almost always necessarily provides results according to a given invention under examination. Indeed, such an analysis relies on impermissible circular reasoning. Thus, a *prima facie* case of obviousness has not been established in the Office Action.

In contrast to the result-oriented analysis proffered in the Office Action, the MPEP specifically states that “the prior art must suggest the desirability of the claimed invention.” The Office Action, in relying only on results, does not identify where the prior art suggests the desirability of the structure for wiring a wiring harness for an automobile as recited above.

In summary, because of the lack of suggestion or motivation in the prior art to modify the reference, the first requirement of MPEP § 2143 has not been met and, hence, a *prima facie* case of obviousness has not been established.

Applicants respectfully submit that independent claim 1 is patentably distinguishable over the cited references and thus, allowable. Moreover, since independent claim 1 is allowable, claims dependent therefrom, namely claims 2, 3, 5 and 6 are also allowable by virtue of their direct or indirect dependence from allowable independent claim 1 and for containing other patentable features. Further remarks regarding the asserted relationship between any of the claims and the cited references are not necessary in view of their allowability. Applicants’ silence as to the Office Action’s comments is not indicative of being in acquiescence to the stated grounds of rejection.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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